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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/557,744	CHENG ET AL.
	Examiner	Art Unit	
	MUNSOON CHOO	2617	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>14 January 2010</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>8-13,15-26 and 28-30</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>8-13, 15-26 and 28-30</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

        1.☒ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 1/14/2010 has been entered.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or
> described as set forth in section 102 of this title, if the differences between the subject
> matter sought to be patented and the prior art are such that the subject matter as a whole
> would have been obvious at the time the invention was made to a person having ordinary
> skill in the art to which said subject matter pertains. Patentability shall not be negatived
> by the manner in which the invention was made.

3.   **Claim 8-13, and 20-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Shieh et al. (Pat# 6,591,098 hereinafter "Shieh") in view of MCI Communications Corporation

(Publish# WO 97/01253 hereinafter "MCI").

Re claim 8, Shieh discloses a subscriber identifying module including a microcontroller

in a mobile telecommunication network which is configured to communicate with at least one

remote system in the mobile communication network (**<u>Abstract: A SIM card is inside a mobile

device (SIM based mobile device). Said mobile device can communicate with the service</u>**

provider (remote system) in the wireless network.), said subscriber identifying module and

said remote system being adapted to store at least one parameter identifying a user in the

network, **(Abstract: SIM card stores subscriber info (parameter) for activation over the air**

with remote system) said subscriber identifying module comprising: (Note: In abstract, the SIM

card and mobile device are incorporated together as one object as a whole, and is regarded as

SIM based mobile device)

a one-time account identifier designed for a one-time logon to the network; and

(Abstract: temporary activation identifiers, temporary electronic serial number).

a permanent account identifier, said permanent account identifier being deactivated;

(C3 L20-34: The actual electronic serial number (permanent account identifier) is

currently deactivated until future registration.)

wherein said one-time and permanent account identifier are prestored in said at least one remote

system, **(C3 L11-20: The HLR (can store SIM card detail inherently) compares the**

temporary electronic serial number (ESN) from the mobile device to the electronic serial

number from the associated vendor (could be Verizon vendor, which is remote system). For

permanent account identifier, it follows the same reason above.) and wherein said

microcontroller is programmed to:

a) use the one-time account identifier to logon to the network when said subscriber identifying

module is switched on;

(Abstract: The temporary ESN. Fig5 ref 300)

b) exchange the one-time account identifier with the permanent account identifier in the

subscriber identifying module upon successful logon to the network as the active account

identifier in a first data processing device; and

(Abstract: Temporary activation identifier is overwritten (should be by the actual ESN))

c) upon successful logon to the network, send an activation request (**abstract: over-the-air**

activation) for deactivating in said at least one remote system an account identifier attached to a

second subscriber identifying module

and activating the permanent account identifier attached to the first data processing device.

(Shieh, Abstract: transmit its actual ESN to complete the activation process (for permanent

account) with the SIM card)

Wherein the step b) is performed in said first data processing device by means of an auto-

activation application executed after receiving a message from the network **(Abstract: the**

network (has data processing device) identifies the temporary electronic serial number and

invokes an over-the-air activation. This occurs after receiving a message from the (mobile

station) network)

informing a successful logon. **(Abstract: After the mobile device has successfully logged into the network, said logon will be informed to the network device so that the activation can be performed, therefore discloses informing a successful logon)**

Shieh didn't specifically disclose: deactivating in said at least one remote system an account identifier attached to a second subscriber identifying module

MCI discloses: deactivating in said at least one remote system an account identifier attached to a second subscriber identifying module

(MCI, abstract, Fig2: The replacement (new) card is fully activated, while the old (second) SIM card is disabled)

It would be obvious to one of ordinary skill in the art to modify Shieh, and have **disabling the old SIM card after the replacement SIM card is fully activated** as taught by MCI, thereby will replacement SIM card in the communication network as discussed by MCI.

Re claim 9, Shieh and MCI as a whole disclose the subscriber identifying module according to claim 8, wherein the account identifier attached to the subscriber identifying module identifies the same account as the account identified by the account identifier attached to a second data processing device.

(MCI: abstract, note: the first device with the replacement SIM card (first SIM) will replace the second device with the old SIM card (second SIM). Therefore, the new SIM

card will identify as the same account as the old SIM card.)

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh and MCI as a whole to produce the invention as claimed with a reasonable expectation of having the mobile device with the new SIM card replacing the mobile device with the old SIM card.

    Re claim 10, Shieh and MCI as a whole disclose the subscriber identifying module according to claim 8, wherein the permanent account identifier attached to the first subscriber identifying module identifies an account which is different from the account identified by the account identifier attached to the second data processing device.

(MCI: page 1, under "Background of The Invention". Note: A user with his individual SIM card (that has permanent account identified for him specifically) can freely use any available terminal (second data processing device) in the network. The newly chosen terminal by the user might have a previously stored account, which is different than the account identified in the user's SIM card.

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh and MCI as a whole to produce the invention as claimed with a reasonable expectation of inserting the user's SIM card into a mobile terminal, and causes the mobile terminal to function according to the account identifier of the user's SIM card.

Re claim 11, Shieh and MCI as a whole disclose the subscriber identifying module according to claim 8, wherein the first subscriber identifying module stores the account identifier attached to the second subscriber identifying module

(MCI: abstract, note: the first device with the replacement SIM card (first SIM) will replace the second device with the old SIM card (second SIM). Therefore, the new SIM card will identify as the same account as the old SIM card and would store the account identifier attached to the second subscriber identifying module. Also, The HLR and AuC will correlate an identifier of the replacement SIM card with an identifier of the original SIM card.)

and the first subscriber identifying module is programmed for transmitting said account identifier attached to the second subscriber identifying module to the said at least one remote system.

(MCI: abstract, note: "Upon first use of the replacement SIM (first subscriber identifying module) card, the network disables the original identifier (second subscriber identifying module) in the HLR (remote system) and AuC (remote system).

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh and MCI as a whole to produce the invention as claimed with a reasonable expectation of having the replacement SIM card logged onto the network, having the HLR and AuC correlate the identifier of the replacement SIM card with the identifier of the original SIM card, and at the end, enabling

the replacement SIM card and disabling the original SIM card.

     Re claim 12, Shieh and MCI as a whole disclose the subscriber identifying module

according to claim 8, wherein said subscriber identifying module is a SIM card.

(Shieh: abstract)

     Re claim 13, Shieh and MCI as a whole disclose the subscriber identifying module

according to claim 8, wherein the logon step a) is performed in a centralized remote system

(Shieh: figure 3, reference 10 is mobile device and reference 114 is MSC/VLR (centralized

remote system), Column 6 lines 21 to 37, Column 5 lines 19 to 23.)

and after receiving the activation request from said device,

(Shieh: Abstract, note: A SIM-over –the-air-activation processor is notified to perform the

activation for the mobile device.)

said centralized remote system sends commands to said at least one remote system

(Shieh: figure 3, reference 10 is mobile device and reference 114 is MSC/VLR (centralized

remote system), Column 6 lines 21 to 37, Column 5 lines 19 to 23. MCI: Figure 1 reference

18 (telephony switches) is the centralized remote system that allows communication access

between mobile equipments (ME reference 12) and remote system of HLR 20, AuC 22 and

Customer Support Center 24.

for exchanging the current active account corresponding to a second data processing device into

the new active account corresponding to the first data processing device.

(MCI: abstract, note: Upon first use of the replacement SIM card, the network disables the original identifier in the HLR and AuC so that subsequent access is solely available to the replacement SIM card. Therefore, the replacement SIM card (as for first device) has taken over the active account of the old SIM card (previously or current active account correspond to the second device.)

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh and MCI as a whole to produce the invention as claimed with a reasonable expectation of having the mobile device with the replacement SIM card replacing the mobile device with the original SIM card.

Re claim 20, Shieh discloses a method for activating a subscriber identifying module in a telecommunication network, said method comprising the steps of:

(Shieh: Abstract)

providing a first subscriber identifying module which stores a one-time account identifier designed for a one-time logon to the network and which also stores a permanent account identifier, said permanent account identifier being deactivated,

(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44. Note: The SIM electronic Serial Number (S-ESN) is a temporary electronic serial number that is used in the registration and activation process (one-time usage).)

(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44. Note: The actual electronic serial number (permanent account identifier) to the mobile device for future registration. The actual electronic serial number is currently deactivated until future registration.)

and send an activation request to a remote network system for activating said permanent account identifier attached to a first data processing device; and

(Shieh: Column 5 line 39 to 46, column 5 line 62 to column 6 line 4. Note: HLR 118 or MC 116 transmit activation notification to SIM-over-the-air-activation processor (SOTAP) to let SOTAP know that an OAA process should be initiated on a registering SIM mobile device.); Abstract, note: The temporary electronic serial number is used when requesting activation for the mobile device (first data processing device). Once the activation is completed, the actual electronic serial number (permanent account identifier attached to the mobile device) will be used for future registrations.; (Column 3 lines 31 to 34: To complete the over-the-air-activation, the actual ESN will overwrite the temporary activation identities.)

said first subscriber identifying module being programmed to automatically, upon successful one-time logon to the network,

(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44.

Before the final step, the network identifies the SIM electronic serial number as the temporary ESN associated with the mobile device, therefore, using the temporary ESN as the active account identifier, the mobile device is successfully logged on to the network,

therefore discloses upon successful one-time logon to the network, first SIM being

programmed to automatically invoke an activation)

exchange the one-time account identifier with the permanent account identifier in said first

subscriber identifying module

(Abstract: Finally, to complete the over-the-air-activation process, the method comprises

setting the usage indicators to transmit the actual ESN in the future and overwriting the

temporary activation identifiers, therefore discloses exchanging the one-time account

identifier with the permanent account identifier in said first SIM)

However, Shieh fails to disclose:

Providing a remote network system which stores an active account identifier attached to a second

subscriber identifying module,

said remote network system being programmed for treating the activation request originating

from the first subscriber identifying module by the operations which include deactivating the

account identifier attached to the second original subscriber identifying module and activating

the account identifier attached to the first subscriber identifying module.

MCI discloses:

Providing a remote network system which stores an active account identifier attached to a second

subscriber identifying module,

said remote network system being programmed for treating the activation request originating

from the first subscriber identifying module by the operations which include deactivating the

account identifier attached to the second original subscriber identifying module and activating

the account identifier attached to the first subscriber identifying module.

(MCI: Abstract, note: Disable (deactivate) the old SIM (second SIM) and enabling the

replacement SIM (first SIM))

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled

in the art would have found it obvious from the combined teachings of Shieh and MCI as a

whole to produce the invention as claimed with a reasonable expectation of enabling the

replacement SIM in the network, and disabling the old SIM in the network.

      Re claim 21, Shieh discloses a data processing device including a microcontroller and

configured to communicate with at least one remote system distributed on a network,

said data processing device and said remote system adapted to store a plurality of parameters

identifying a user account belonging to a subscriber

(Shieh: Abstract, column 1 lines 20 to 32. Note: A subscriber identification module (SIM)

is inside a mobile device. Said mobile device is able to communicate with the service

provider (remote system) in the wireless network. Said service provider enters activation

data (parameter) into the wireless network related to the individual and the mobile device

identification, and therefore, the wireless network will recognize the user and mobile

device.),

said data processing device comprising:

a one-time parameter comprising the active account attached to said data processing device

designed for a one-time use; and

(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44. Note: The SIM electronic Serial

Number (S-ESN) is a temporary electronic serial number (parameter) that is used in the

registration and activation process (one-time usage as an active account).

a permanent parameter identifying an account attached to said data processing device,

said permanent parameter being deactivated;

(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44. Note: The actual electronic serial

number (permanent account identifier) to the mobile device for future registration. The

actual electronic serial number is currently deactivated until future registration. Column 3

lines 31 to 34: To complete the over-the-air-activation, the actual ESN will overwrite the

temporary activation identities.)

wherein said one-time and permanent parameter are stored in said at least one remote system,

(Shieh: Column 3 lines 11 to 20, column 5 lines 39 to 46, claim# 16. Note: The HLR (remote

system) compares the temporary electronic serial number (one-time account identifier)

from the mobile device to the electronic serial number from the associated vendor. Thus,

the temporary electronic serial number is pre-stored in the remote system. In column 2

lines 59 to 61, the network identifies the manufacture of the SIM card for specifications.

The actual ESN number (permanent account identifier) is inherently stored in the

associated vendor.)

And wherein said microcontroller is programmed to:

a) Using the one-time parameter to logon to the network when said data processing device is switched on; and

(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44. Note: During registration, the mobile device transmits the activation identifier and the SIM electronic serial number as the card identifier to the wireless network. The mobile device is turned on during registration.

The S-ESN is a temporary electronic serial number, which is a parameter.)

b) Exchanging the one-time parameter with the permanent parameter, upon successful logon to the network,

(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44.

Before the final step, the network identifies the SIM electronic serial number as the temporary ESN associated with the mobile device, therefore, using the temporary ESN as the active account identifier, the mobile device is successfully logged on to the network.

Note: Finally, to complete the over-the-air-activation process, the method comprises setting the usage indicators to transmit the actual ESN in the future and overwriting the temporary activation identifiers.

The actual electronic serial number (ESN) is the parameter for permanent active account

because it will overwrite the temporary activation identifiers and become useful for the

future.)

said permanent parameter becoming the permanent active account,

(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44.

The actual electronic serial number (ESN) is the parameter for permanent active account

because it will overwrite the temporary activation identifiers and become useful for the

future.)

However, Shieh fails to disclose:

wherein a first data processing device and said at least one remote system store a parameter

identifying a current active account attached to a second data processing device to replace,

and upon successful logon to the network,

a program automatically stored in said first data processing device sends an activation request for

exchanging the plurality of parameters from the old for the new one in said at least one remote

system,

with the current active account being deactivated.

MCI discloses:

wherein a first data processing device and said at least one remote system store a parameter

identifying a current active account attached to a second data processing device to replace,

(MCI: Abstract, note: First device has replacement SIM, since it will replace the old SIM

card, it has the parameter identifying the current active account of the second data

processing device (with old SIM) and the HLR and AuC (Remote system) has parameter

for the current active account for the second data processing device (to be replaced)

because HLR and AuC will be correlated by administrator. The second data processing

device is the device that uses the old SIM card, and will be replaced.)

and upon successful logon to the network,

a program automatically stored in said first data processing device sends an activation request for

(MCI: figure 2, note: "Replacement SIM card Fully activated".

Abstract: Authentication Center (AuC) is for activation.)

exchanging the plurality of parameters from the old for the new one in said at least one remote

system,

(MCI: abstract, note: The replacement (new SIM card) SIM card will take over the

parameters (subscriber's detail) from the old SIM card.

Page 5 line 9, page 3 line 6 to 8 mention repeated rewriting of data to memory, which shows

the functionally of exchanging data or parameters.)

with the current active account being deactivated.

(MCI: abstract, note: disabling the old SIM card will deactivate the current active account)

Shieh discloses:

Wherein the step b) is performed in said first data processing device by means of an auto-

activation application executed after receiving a message from the network **(Abstract: the**

network (has data processing device) identifies the temporary electronic serial number and

invokes an over-the-air activation. This occurs after receiving a message from the (mobile

station) network)

informing a successful logon. **(Abstract: After the mobile device has successfully logged into**

the network, said logon will be informed to the network device so that the activation can be

performed)

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled

in the art would have found it obvious from the combined teachings of Shieh and MCI as a

whole to produce the invention as claimed with a reasonable expectation of enabling the

replacement SIM card, disabling the old SIM card in the network, and have the replacement SIM

card replaces the old SIM card by copying the subscriber's detail from the old SIM card to the

replacement SIM card.

　　　Re claim 22, Shieh and MCI as a whole disclose the data processing device of claim 21,

wherein said activation request includes

at at least one of at least one old parameter and at least one new parameter

(Shieh: abstract, note: The temporary electronic serial number associated with the SIM

vendor is a new parameter for the network.)

for identifying the device requesting an account activation

(Shieh: abstract.)

     Re claim 23, Shieh and MCI as a whole disclose the data processing device of claim 21,

wherein said one-time parameter is the same for a set of data processing devices replacing a

respective old data processing device.

(Shieh: abstract, note: the one-time parameter could be an international mobile station

identity (IMSI) and/or mobile identification number (MIN), and a temporary electronic

serial number. MIN is a parameter, which is accompanied by a value (number).)

(MCI: abstract. Note: When the replacement SIM card is inserted into any available

terminal, its IMSI parameter will be the same for any of the chosen terminal.)

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled

in the art would have found it obvious from the combined teachings of Shieh and MCI as a

whole to produce the invention as claimed with a reasonable expectation of having the

replacement SIM card includes identifying parameters such as IMSI, MIN or temporary

electronic serial number, and having any mobile terminal in the network capable of transmitting

value of these parameters to the telephony switches or to the remote system.

     Re claim 24, Shieh and MCI as a whole disclose the data processing device of claim 21,

wherein the subscriber switches on said data processing device.

(Shieh: column 1 lines 40 to 49, note: when a mobile device is first used (it is switched on by

said subscriber)

Re claim 25, Shieh and MCI as a whole disclose the data processing device of claim 21,

wherein after receiving the activation request from said first data processing device,

(Shieh: Abstract, note: A SIM-over –the-air-activation processor is notified to perform the

activation for the mobile device.)

A centralized remote system sends commands to said at least one remote system

(Shieh: figure 3, reference 10 is mobile device and reference 114 is MSC/VLR (centralized

remote system). Column 6 lines 21 to 37. Column 5 lines 19 to 23.)

(MCI: Figure 1 reference 18 (telephony switches) is the centralized remote system that

allows communication access between mobile equipments (ME reference 12) and remote

system of HLR 20, AuC 22 and Customer Support Center 24.

for exchanging the current active account corresponding to the second data processing device

into the new active account corresponding to the first data processing device.

(MCI: abstract, note: Upon first use of the replacement SIM card, the network disables the

original identifier in the HLR and AuC so that subsequent access is solely available to the

replacement SIM card. Therefore, the replacement SIM card (as for first device) has taken

over the active account of the old SIM card (previously or current active account

correspond to the second device.)

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh and MCI as a whole to produce the invention as claimed with a reasonable expectation of having the mobile device with the replacement SIM card replacing the mobile device with the original SIM card.

Re claim 26, Shieh and MCI as a whole disclose the data processing device of claim 21, wherein the logon step a) is performed in a centralized remote system

(Shieh: figure 3, reference 10 is mobile device and reference 114 is MSC/VLR (centralized remote system). Column 6 lines 21 to 37. Column 5 lines 19 to 23.)

and after receiving the activation request from said first data processing device,

(Shieh: Abstract, note: A SIM-over –the-air-activation processor is notified to perform the activation for the mobile device.)

said centralized remote system sends commands to said at least one remote system

(Shieh: figure 3, reference 10 is mobile device and reference 114 is MSC/VLR (centralized remote system). Column 6 lines 21 to 37. Column 5 lines 19 to 23.)

(MCI: Figure 1 reference 18 (telephony switches) is the centralized remote system that allows communication access between mobile equipments (ME reference 12) and remote system of HLR 20, AuC 22 and Customer Support Center 24.

for exchanging the current active account corresponding to the second data processing device

into the new active account corresponding to the first data processing device.

(MCI: abstract, note: Upon first use of the replacement SIM card, the network disables the

original identifier in the HLR and AuC so that subsequent access is solely available to the

replacement SIM card. Therefore, the replacement SIM card (as for first device) has taken

over the active account of the old SIM card (previously or current active account

correspond to the second device.)

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled

in the art would have found it obvious from the combined teachings of Shieh and MCI as a

whole to produce the invention as claimed with a reasonable expectation of having the mobile

device with the replacement SIM card replacing the mobile device with the original SIM card.

4.   **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Shieh and in

view of Shannon et al. (Patent# 6,285,869 hereinafter "Shannon").

Re claim 15, Shieh discloses a remote telecommunication system in a mobile telecommunication

network, wherein the remote telecommunication system is configured for communicating with a

subscriber identifying module, said remote telecommunication system storing:

(Shieh: Abstract, column 1 lines 20 to 32. Note: A subscriber identification module (SIM) is

inside a mobile device. Said mobile device is able to communicate with the service provider

(remote system) in the wireless network.)

a one-time account identifier for a one-time logon of a subscriber identifying module to the

network

(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44. Note: The SIM electronic Serial

Number (S-ESN) is a temporary electronic serial number that is used in the registration

and activation process (one-time usage).

a permanent account identifier attached to an original data processing device; and

(Shieh: Column 3 lines 1 to 34 and column 4 line 29 to 44. Note: The actual electronic serial

number (permanent account identifier) to the mobile device (data processing device) for

future registration.)

However, Shieh fails to disclose:

a set of instructions for accepting logon of a replacement subscriber identifying module

in the network

and treating an activation request from the replacement subscriber identifying module by

the following operations:

deactivating the account identifier attached to the original subscriber identifying module

and, activating the account identifier attached to the replacement data processing device.

Shannon discloses a set of instructions for accepting logon of a replacement subscriber

identifying module in the network

(Shannon: Column 2 line 51-59, note: From time to time, this card requires replacement.

The system of figure 1 is a network system.)

and treating an activation request sent from an auto-activation application executed in the

replacement subscriber identifying module by the following operations:

(Shannon, abstract: The new identity code from the new (replacement) SIM card can be

sent to the network as an activation request)

deactivating the account identifier attached to the original subscriber identifying module

(Shannon: abstract)

and, activating the account identifier attached to the replacement data processing device.

(Shannon: abstract)

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled

in the art would have found it obvious from the combined teachings of Shieh and Shannon as a

whole to produce the invention as claimed with a reasonable expectation of enabling the

replacement SIM in the network, and disabling the old SIM in the network.

5.   Claims **16-18 are** rejected under 35 U.S.C. 103(a) as being unpatentable over Shieh and

Shannon as applied to claim 15 above, and further in view of MCI.

        Re claim 16, Shieh and Shannon as a whole disclose

the remote telecommunication system according to claim 15, but fails to disclose wherein the remote telecommunication system is programmed for associating the account identifier attached to the original subscriber identifying module with the same account as the account identified by the account identifier attached to the replacement data processing device. However, MCI does.

(MCI: abstract, note: the first device with the replacement SIM card (new SIM) will replace the second device with the old SIM card (original SIM). Therefore, the new SIM card will identify as the same account as the old SIM card.

Note: "Administrator to correlate (associate) an identifier of the replacement SIM card with an identifier of the original SIM card").

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh, Shannon and MCI as a whole to produce the invention as claimed with a reasonable expectation of having the mobile device with the replacement SIM card replacing the mobile device with the original SIM card.

Re claim 17, Shieh and Shannon as a whole disclose the remote telecommunication system according to claim 15, but fails to disclose wherein the remote telecommunication system is programmed for associating the permanent account identifier attached to the first subscriber identifying module to an account which is different from the account identified by the account identifier attached to the second data processing device. However, MCI does.

(MCI: page 1, under "Background of The Invention". Note: A user with his individual SIM card (that has permanent account identified for him specifically) can freely use any available terminal (second data processing device) in the network. The newly chosen terminal by the user might have a previously stored account, which is different than the account identified in the user's SIM card. As for associating the user's SIM card account to the account attached to the second data processing device: Since the user can freely use any terminal in the network, then after the user chooses a terminal by inserting his SIM card into the chosen terminal, the network will associate the user's SIM card with said chosen terminal.)

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled in the art would have found it obvious from the combined teachings of Shieh, Shannon and MCI as a whole to produce the invention as claimed with a reasonable expectation of the user inserting his SIM card into the mobile terminal and he can start using the mobile terminal as his mobile phone.

Re claim 18, Shieh and Shannon as a whole disclose the remote telecommunication system according to claim 15, but fails to disclose wherein the remote system determines the account identifier to be deactivated from the account identifier attached to the second processing device as transmitted by the first data processing device. However, MCI does.

(MCI: Abstract, note: The old SIM card (for the second processing device) is to be deactivated, when the replacement SIM card (for the first data processing device) uses the network for the first times.)

Motivation to combine may be gleaned from the prior art contemplated. Therefore, one skilled

in the art would have found it obvious from the combined teachings of Shieh, Shannon and MCI

as a whole to produce the invention as claimed with a reasonable expectation of having the

mobile device with the replacement SIM card replacing the mobile device with the original SIM

card, therefore, enabling the replacement SIM card and disabling the original SIM card in the

network.

6.   Claims **19** rejected under 35 U.S.C. 103(a) as being unpatentable over Shieh, and further

in view of Shannon and Borngraber (US 20040120552 hereinafter "Born").

Re claim 19, Shieh and Shannon as a whole disclose the remote telecommunication

system according to claim 15,

Shieh discloses wherein the one-time account identifier **(Shieh; abstract, note; the one-time**

parameter could be an international mobile station identity (IMSI) and/or mobile

identification number (MIN), and a temporary electronic serial number. MIN is a

parameter, which is accompanied by a value (number)) is different for a set of subscriber

identifying modules in the network.

Shieh didn't specifically disclose: is the same for a set of SIM.

Born discloses: is the same for a set of subscriber identifying modules.

(Born, P [80]: the authentication key "is the same for a set of SIM cards in the network")

It would be obvious to one of ordinary skill in the art to modify <u>Shieh,</u> and have <u>the</u>

<u>same authentication key for a set of SIM cards</u>   as taught by <u>Born</u>, thereby <u>will enable</u>

<u>access control (P [6])</u>   as discussed by <u>Born</u>.

7.   Claims **28-30** rejected under 35 U.S.C. 103 (a) as being unpatentable over Shieh, and

further in views of MCI and Born.

Re claim 28-30, these claims correspond to claim 19.

<div align="center">Conclusion</div>

        Any inquiry concerning this communication or earlier communications from the
examiner should be directed to MUNSOON CHOO whose telephone number is (571)270-7140.
The examiner can normally be reached on Monday through Friday 7:30am to 5pm.
        If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Vu Le can be reached on (571)272-7332. The fax phone number for the organization
where this application or proceeding is assigned is 571-273-8300.
        Information regarding the status of an application may be obtained from the Patent
Application Information Retrieval (PAIR) system. Status information for published applications
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like assistance from a USPTO Customer Service Representative or access to the automated
information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Munsoon Choo/

Examiner, Art Unit 2617

/NICK CORSARO/

Supervisory Patent Examiner, Art Unit 2617